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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,928	07/30/2003	Raoul Kopelman	UM-08240	9504
	7590 09/23/2004		EXAMINER EVANS, FANNIE L	
Peter G. Carroll MEDLEN & CARROLL, LLP Suite 350 101 Howard Street San Francisco, CA 94105			ART UNIT 2877	
DATE MAILED: 09/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,928

Applicant(s)

KOPELMAN ET AL.

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-25 and 34-43 is/are allowed.
- 6) ☒ Claim(s) 1,5,7,9,13,15,26,30 and 33 is/are rejected.
- 7) ☒ Claim(s) 2,3,6,8,10-12,14,16,27-29,31 and 33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The Drawings

Formal drawings in accordance with 37 CFR § 1.84 are required.

Corrected drawing sheets in compliance with 37 CFR § 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR § 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 7, 9, 13, 15, 26, 30 and 32 are rejected under 35 U.S.C. § 102(b) as being

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clearly anticipated by Alderete et al (US 5,714,121).

With respect to claims 1, 5 and 7, Alderete et al disclose an optical fiber (12) comprising a tip, said tip comprising a fluorescent compound (sentence bridging columns 5 and 6) attached to/in contact with to metal (lines 20-24 and 42-46 of column 5), said fluorescent compound selected from the group consisting of fluorescein and fluorescein derivatives (sentence bridging columns 5 and 6). The metal can be titanium dioxide (lines 28-30 of column 5) and the metal can be spherical particles (lines 45 and 46 of column 5). The fiberless sensor of claims 9, 13 and 15 reads on the contents of the capsule (14) prior to being attached to fiber (12). The steps of the method of claims 26, 20 and 32 are performed when preparing the fiber sensor of Alderete et al.

Allowable Subject Matter

Claims 2-4, 6, 8, 10-12, 14, 16, 27-29, 31 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 17-25 and 34-43 are allowed over the prior art of record.

As to claims 2-4, 10-12 and 27-29, the prior art of record, taken alone or in combination, fails to disclose or render obvious the use of a metal layer/monolayer, in combination with the rest of the limitations of the claims.

As to claims 6, 14 and 31, the prior art of record, taken alone or in combination, fails to disclose or render obvious the use of gold as the metal, in combination with the rest of the limitations of the claims.

As to claims 8, 16 and 33, the prior art of record, taken alone or in combination, fails to

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disclose or render obvious the use of difluorofluorescein or diamino fluorescein as the fluorescein derivative, in combination with the rest of the limitations of the claims.

As to claim 17, the prior art of record, taken alone or in combination, fails to disclose or render obvious the treating and mixing steps, in combination with the rest of the limitations of the claim.

As to claim 34, the prior art of record, taken alone or in combination, fails to disclose or render obvious the step of providing, in combination with the rest of the limitations of the claim.

Fax/Telephone Numbers

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number is (703) 872-9306 for regular and After Final communications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached on (571) 272-2800 ext 77.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


F. L. EVANS
PRIMARY EXAMINER
ART UNIT 2877

file
September 16, 2004